



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,910	04/26/1999	NORIYOSHI SONETAKA	Q54131	2573

7590 07/16/2003

SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE N W
WASHINGTON, DC 200373202

[REDACTED] EXAMINER

WEST, LEWIS G

ART UNIT	PAPER NUMBER
2682	24

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/298,910	SONETAKA, NORIYOSHI
Examiner	Art Unit	
Lewis G. West	2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10, 12, 14, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 10, 12, 14, 16 and 17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 August 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

Response to Arguments

1. Applicant's arguments filed June 11, 2003 have been fully considered but they are not persuasive. Bilgic discloses sending each digit to the base station, as it is dialed (see column 11 lines 8-24). Arguments against Bilgic are related to an uncited embodiment and are not persuasive as they do not address the rejection. Suonvieri discloses different functions that may be interchangeably carried out in a base station or a base station controller. Therefore it is not patentably distinct to take a known process and move it from the base station to the base station controller.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Digits are sent to a base station control station but then analysis is supposedly performed at the base station. It is assumed for examination that digits are sent to the base station; otherwise claim 16 and 17 would be identical.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 10 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Bilgic (US 5,884,148).

Regarding claim 10, Bilgic discloses a radio access system comprising: means for producing dialing signals (col. 10 line 22-col. 11 line 24); means for transmitting the dialing signals to a base station each time they are produced (col. 11 lines 8-24) and a base station in radio communication with said means for producing dialing signals (col. 11 line 25-38), said base station including means for deciding whether a dialing signal represents a final digit of a dialed telephone number or not, (col. 11 line 39-48) wherein said means for producing dialing signals includes a telephone set having a dial pad with keys, a dialing signal being generated when a key of said dial pad is pushed (col. 11 line 39-48)

Regarding claim 16, Bilgic discloses a radio access method comprising the steps of: producing dialing signals when a key of a dial pad is pushed; transmitting dialing signals to a

base station each time they are produced; and deciding at a base station whether a dialing signal represents a final digit of a dialed telephone number or not. (Col. 11 lines 8-48)

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 12, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilgic (US 5,884,148) in view of Suonvieri (6,047,181).

Regarding claim 12, Bilgic discloses a radio access system comprising: means for producing dialing signals (col. 10 line 22-col. 11 line 24); means for transmitting the dialing signals each time they are produced (col. 11 lines 8-24) and a base station in radio communication with said means for producing dialing signals (col. 11 line 25-38), said base station including means for deciding whether a dialing signal represents a final digit of a dialed telephone number or not, (col. 11 line 39-48) wherein said means for producing dialing signals includes a telephone set having a dial pad with keys, a dialing signal being generated when a key of said dial pad is pushed (col. 11 line 39-48) Bilgic does not expressly disclose digit analysis in the base station control station. However, Suonvieri discloses that some functions, including timer functions, may be carried out either in the base station or the base station controller. (Col. 5 lines 19-39) It would have therefore been obvious to one of ordinary skill in the art at the time of the invention to send digits to and perform digit analysis in the base station control station to avoid repeated circuitry or software updates in multiple base stations.

Regarding claim 14, Bilgic discloses a radio access system comprising: means for producing dialing signals (col. 10 line 22-col. 11 line 24); means for transmitting the dialing signals each time they are produced (col. 11 lines 8-24) and a base station in radio communication with said means for producing dialing signals (col. 11 line 25-38), said base station including means for deciding whether a dialing signal represents a final digit of a dialed telephone number or not, (col. 11 line 39-48) wherein said means for producing dialing signals includes a telephone set having a dial pad with keys, a dialing signal being generated when a key of said dial pad is pushed (col. 11 line 39-48) Bilgic does not expressly disclose digit analysis in the base station control station. However, Suonvieri discloses that some functions, including timer functions, may be carried out either in the base station or the base station controller. (Col. 5 lines 19-39) It would have therefore been obvious to one of ordinary skill in the art at the time of the invention to send digits to and perform digit analysis in the base station control station to avoid repeated circuitry or software updates in multiple base stations.

Regarding claim 17, Bilgic discloses a radio access method comprising the steps of: producing dialing signals when a key of a dial pad is pushed; transmitting dialing signals each time they are produced; and deciding at a base station control station whether a dialing signal represents a final digit of a dialed telephone number or not.(column 11) Bilgic does not expressly disclose digit analysis in the base station control station. However, Suonvieri discloses that some functions, including timer functions, may be carried out either in the base station or the base station controller. (Col. 5 lines 19-39) It would have therefore been obvious to one of ordinary skill in the art at the time of the invention to send digits to and perform digit analysis in the base station control station to avoid repeated circuitry or software updates in multiple base stations.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 703-308-9298. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.


Lewis West
(703) 308-9298
July 10, 2003


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600
